

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Richard G. Moore <i>et al.</i>	Confirmation No.: 3124
Application No.: 09/873,001	Examiner: Kelly Scaggs Campen
Filed: June 1, 2001	Group Art Unit: 3691
Attorney Docket No.: CDR00007	

For: SYSTEM AND METHOD FOR PROVIDING PREPAID SERVICES VIA AN  
INTERNET PROTOCOL NETWORK SYSTEM

Commissioner for Patents  
Alexandria, VA 22313-1450

**REPLY BRIEF**

Dear Sir:

This Reply Brief is submitted in response to the Examiner's Answer mailed September 3, 2009.

**I. STATUS OF THE CLAIMS**

Claims 29-50 are pending and are on appeal. Claims 1-28 have been previously canceled. No claims are allowed.

**II. GROUND OF REJECTION TO BE REVIEWED**

Whether claims 29-41 are obvious under 35 U.S.C. § 103 based on *Domenikos et al.* (US2001/0047386) in view of *Anderson et al.* (US 2002/0091572)?

Whether claims 42-48 are obvious under 35 U.S.C. § 103 based on *Anderson et al.* (US 2002/0091572) in view of *Domenikos et al.* (US2001/0047386)?

Whether claim 49 is obvious under 35 U.S.C. § 103 based on *Anderson et al.* (US 2002/0091572) in view of *Mackenthun* (US 5,969,318)?

Whether claim 50 is obvious under 35 U.S.C. § 103 based on *Anderson et al.* (US 2002/0091572) and *Mackenthun* (US 5,969,318) in view of *Bellosguardo* (US 7,222,097)?

### III. ARGUMENT

Appellants maintain and rely on the arguments set forth in the principal Appeal Brief of June 1, 2009, which are incorporated herein by reference. Additionally, Appellants provide the following comments with regard to the Examiner's response in the Examiner's Answer:

In response to Appellants' argument that there would have been no reason to combine the *Domenikos et al.* and *Anderson et al.* references, the Examiner has asserted (Answer-page 11) that "KSR forecloses Applicant's argument that a specific teaching is required for a finding of obviousness (KSR, 127 S.Ct at 1741, 82 USPQ2d at 1396)" and that the Examiner's assertion that "there is desirability in the convenience of being able to manage multiple accounts at a single portal" is enough for concluding obviousness. Appellants disagree.

Respectfully, *KSR* does not nullify Appellants' claims by an Examiner's subjective test as to what would have been obvious. A step in the obviousness analysis is to "determine whether there was an **apparent reason to combine** the known elements in the fashion claimed" (emphasis added). *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). A rejection for obviousness must include "articulated reasoning with some rational underpinning to support the legal conclusion." *Id.*, quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). The proper question to ask is whether a person of ordinary skill in the art would have seen a benefit to

combining the prior art teachings. *KSR*, 550 U.S. at 424. No such benefit is apparent in combining *Domenikos et al.* and *Anderson et al.*

The Examiner's assertion that "there is desirability in the convenience of being able to manage multiple accounts at a single portal" is insufficient for sustaining the Examiner's obviousness conclusion for two reasons. First, it was Appellants who recognized this "convenience." See, e.g., page 6, lines 3-5, of the instant specification, in listing the advantages of the present invention: "(2) the capability of bundling a host of prepaid services to reduce delivery costs and **allow the subscriber to interact with only one service provider** for all kinds of prepaid services" (emphasis added). Second, a mere "desire" to accomplish something does not, *per se*, make it obvious as to how to actually accomplish the thing.

In responding to Appellants' argument that neither *Domenikos et al.* nor *Anderson et al.* discloses the subject matter of claim 42, the Examiner cites *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981) for the proposition that one cannot show nonobviousness by attacking references individually, where the rejections are based on combinations of references (Answer-page 11). Appellants agree with this tenet of patent law, but assert that Appellants were attacking the combination and not the references, individually. As argued at pages 8-10 of the principal brief, *Anderson et al.* is devoid of any disclosure of a request from a user "**for information relating to a plurality of prepaid services** offered by a plurality of prepaid service providers" and *Domenikos et al.* does not provide for this deficiency of *Anderson et al.* because *Domenikos et al.* provides for consumers to purchase products such as services online and in real time from a plurality of different vendors. There would have been no reason to modify *Anderson et al.* with the teachings of *Domenikos et al.* to provide for user interaction with accounts of a plurality of vendors because **the prepaid system of *Anderson et al.* is within the possession of but a single**

**service provider.** The single service provider is unlikely to share its secure business property (including customer databases, profiles, and sensitive financial information) with other service providers, something which would be necessary in the modification proposed by the Examiner but, which, in the real world, simply does not happen. Those of ordinary skill in the art would have recognized this flaw in the Examiner's rationale for making the proposed combination. Accordingly, in a real world situation, the combination of *Domenikos et al.* with *Anderson et al.* would never have been suggested to the skilled artisan in the art of providing online services.

Thus, it is clear that Appellants' argument goes to the combination of references, and is not merely an attack against the references individually.

At pages 12-13 of the Answer, the Examiner asserts the propriety of combining the references based on *Anderson et al.* disclosing a single service provider offering services within a single interface and *Domenikos et al.* providing for a single interface for interfacing with a plurality of service providers offering services, arguing that the combination would have *Anderson et al.* providing a single interface to access a plurality of services, which contains different accounts for each user, and like *Domenikos et al.*, one for every service of every service provider with which the user maintains an account.

The proposed combination would not have been made by skilled artisans for the reasons above and for the reasons stated in the principal brief. Moreover, for simple business and security reasons, the skilled artisan would never have sought to combine the references in the manner asserted by the Examiner because to do so would open up a single service provider's accounts to viewing by other service providers. The combination asserted by the Examiner would not have been made from either a business point of view or a common sense point of view. The only possible reason for making the combination, wherein the user interaction with a single

service provider in *Anderson et al.* is modified with a teaching of multiple service providers in *Domenikos et al.*, is impermissible hindsight gleaned from a knowledge of Appellants' disclosure. This, of course, is improper under 35 U.S.C. § 103.

At pages 13-14 of the Answer, the Examiner asserts that Appellants' arguments regarding claims 29 and 42 are in error because *Anderson et al.* teaches a feature that could be used to improve *Domenikos et al.*, viz., that one would modify *Domenikos et al.* to include an interface where a user can view data related to multiple accounts because *Anderson et al.* teaches that typical prepaid systems lack a centralized access point for viewing information for multiple prepaid accounts and *Domenikos et al.* provides multiple accounts from a plurality of prepaid service providers. Appellants respectfully disagree.

*Anderson et al.* does not teach that typical prepaid systems lack a centralized access point for viewing information **for multiple prepaid accounts** because *Anderson et al.* is only concerned with a single service provider. There are multiple accounts in the sense that a single customer can view both a "prepaid" account and a "postpaid" account (end of paragraph [0029]), but there is no suggestion in *Anderson et al.* of viewing a plurality of prepaid accounts from a plurality of prepaid service providers because there is but a single service provider. In any event, it would not have been obvious to modify *Domenikos et al.* to include an interface where a user can view data related to multiple accounts via the teachings of *Anderson et al.* because neither reference suggests an interface where a single user can view accounts relative to a plurality of prepaid service providers.

At pages 14-15 of the Answer, the Examiner asserts that Appellants' argument relative to claim 49 is in error because "Mackenthuss makes up for the deficiencies of Anderson by teaching prepaid services presented together in a central access point for purchasing, as taught by

Anderson, as a ‘packaged solution’ by Anderson, to be presenting the multiple services as bundled services, as claimed.” Appellants disagree.

As explained in the principal brief, modifying *Anderson et al.* with the teachings of *Mackenthun* would, at best, result in a system having a plurality of prepaid systems 50, which would still not meet the claimed feature of “presenting, via a web interface, the prepaid service of the first provider and the prepaid service of the second provider **as a bundled service.**” The “packaged solution” disclosed by *Anderson et al.* is simply not the claimed “bundled service” because *Anderson et al.*, again, discloses only a single service provider. Therefore, since there is no first service provider **and** a second service provider in *Anderson et al.*, there can be no disclosure of a “bundled service” where such “bundled service” comprises “the prepaid service of the first provider and the prepaid service of the second provider,” as claimed. The mere disclosure by *Mackenthun* of connecting a card requester with multiple card service providers does not fill in the gaps of *Anderson et al.* relating to “presenting, via a web interface, the prepaid service of the first provider and the prepaid service of the second provider **as a bundled service.**”

**IV. CONCLUSION AND PRAYER FOR RELIEF**

The claims require transmitting to a user “user account information stored in a user profile” where the user account information identifies “the prepaid services of a plurality of the prepaid service providers” and “presenting, via a web interface, the prepaid service of the first provider and the prepaid service of the second provider **as a bundled service**” but the combinations of applied references are devoid of such features. Appellants, therefore, request the Honorable Board to reverse each of the Examiner’s rejections.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

DITTHAVONG MORI & STEINER, P.C.

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